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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARKUS LAUTENBACHER

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Appeal 2009-000931  
Application 09/868,277  
Technology Center 2400

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Decided:<sup>1</sup> July 27, 2009

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Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and  
THU A. DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 16-20, 24-26, 30, and 31. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### *Invention*

Appellant's invention relates to a server that stores application programs until a user requests a specific application program. The user downloads the specific application to the user's terminal where the application program is executed. (App. Br. 2-3.)

### *Representative Claim*

16. In an IP-based network, a system comprising:
  - at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis;
  - and
  - at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.

*Prior Art*

The Examiner relies on the following references as evidence of unpatentability.

Brocker	5,365,606	Nov. 15, 1994
Devarakonda	6,757,729 B1	Jun. 29, 2004

*Examiner's Rejections/Claims*

Claims 16-20, 24-26, 30, and 31 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 16-20 and 24-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Devarakonda.

Claims 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Devarakonda and Brocker.

Claims 1-15 and 21-23 have been canceled. Claims 27-29 have been withdrawn from consideration as being directed to a non-elected invention.

PRINCIPLES OF LAW -- WRITTEN DESCRIPTION

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed

invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

#### ANALYSIS -- WRITTEN DESCRIPTION

The Examiner finds that “the added limitation of interworking programs with applications on at least one other terminal is not founded [sic] in the specification.” (Ans. 3.) The “added limitation” is not identified, but appears to correspond to the claim 16 language of “said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.”

According to Appellant, support for “the added limitation” can be found “in paragraphs 0018-0013 [sic] and paragraph 0059 in the second substitute specification filed February 9, 2005.” (App. Br. 5.) The Reply Brief, submitted by a different attorney, greatly expands on what some unidentified “specification” is alleged to teach with respect to what constitutes an “interworking relationship.” (*See* Reply Br. 4.)

In any event, in the footnote at page 5 of the Appeal Brief, Appellant references the “originally filed application” at page 5, lines 29 through 33. The “second substitute specification,” filed February 9, 2005, contains a paragraph that is identical in substance with the referenced material in the original application:

[0020] User services are services to the end user resulting from the interworking of network-aware applications which operate above IP-Model Layer 3 (typically even above IP-Model Layer 5) in intelligent terminals at the edges of the network, e.g. e-mail, WWW [World Wide Web], Buddy Lists, Internet Telephony, etc.

We thus interpret the “downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services” as merely requiring that the downloadable programs contain an application (such as electronic mail) that can be used with similar applications on another terminal in the network, when and if the programs are downloaded.

We note that the Examiner also rejects the other independent claim (claim 24) under the first paragraph of § 112. The claim recites that “user downloadable application software” is “configured to interwork with the application software on at least one other terminal of the network for realizing user services,” which is less difficult to parse than the language of claim 16. Claim 16 speaks of “application programs” on a server, “downloadable programs” inherently on the server, and “the applications programs” -- which lacks proper antecedent basis in the claim -- on at least one other terminal of the network. Although claim 16 does not recite or require any actual “downloading,” if the “downloadable programs” were downloaded to the terminal “coupled” to the server, the programs would be “application” programs with respect to that terminal.

In the Examiner’s view, “the downloadable program does not interwork with application software. Rather, it is simply application software itself that interworks.” (Ans. 7.)

Claim 24, however, recites that application software is configured to interwork with application software, which appears consistent with the Examiner’s statement with respect to what “interworks.” Although claim 16 lacks clarity, the Examiner has not rejected the claim under the second

paragraph of § 112. In our best understanding of claim 16, as noted above, the “downloadable” programs on the server that the claim does not require to be downloaded would be “application” programs if they were to be downloaded. The not-recited *downloaded* programs would be capable of interworking with corresponding application programs on the network, which would also appear to be consistent with the Examiner’s view of what “interworks.”

Although claim 16 appears to say that the “downloadable” programs on the server are “configured to interwork” with “the” application programs on a network terminal other than the “at least one terminal coupled to the server,” we read the claim as meaning that the downloadable programs on the server, if downloaded to the “at least one terminal,” would be capable of “interworking” with corresponding application programs on another terminal of the network. Similarly, we understand the “application software” of claim 24 as capable of interworking with application software on another terminal *when and if* downloaded to a requesting terminal, rather than capable of “interworking” from the recited “server.”

Thus, based on our understanding of what the claims require, we find that the Examiner has not met the initial burden in demonstrating that the original disclosure fails to show possession of the invention now claimed. We thus do not sustain the rejection of claims 16-20, 24-26, 30, and 31 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

### *Claim Groupings*

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal with respect to anticipation on the basis of claim 16 alone, and the appeal with respect to obviousness on the basis of claim 30 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### FINDINGS OF FACT

#### *Devarakonda*

1. Devarakonda describes service providers 104(1) through 104(3) (Fig. 1) and network computers 106(1), 106(2). Col. 2, ll. 7-26.
2. Each network computer includes a Virtual Environment Manager (VEM) 108(1), 108(2) that is downloaded from a service provider via communication network 112. *Id.*, ll. 41-43.
3. Once a VEM has been downloaded and initialized, applications (APs) can be downloaded from the service providers. Col. 4, ll. 12-24 and 43-45; Fig. 4.
4. A web browser 114(1), 114(2) (Fig. 1) and home page (Fig. 6) may be downloaded from the service providers. Col. 3, ll. 3-38.

### PRINCIPLES OF LAW -- ANTICIPATION AND OBVIOUSNESS

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).



“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

## ANALYSIS -- PRIOR ART REJECTIONS

### *Anticipation*

Appellant alleges that the rejection of claim 16 over Devarakonda is in error by submitting that the reference discloses “services provided and executed by the network” and that the application execution component (AXE) described in the “present application” is “not equivalent” to Devarakonda’s VEM. (App. Br. 8-9.) However, the general allegations of differences between the presently disclosed invention and the reference do not show error in the Examiner’s finding of anticipation.

With respect to what is actually claimed, the language that Appellant deems to distinguish over Devarakonda is “said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.” (*Id.* at 8.)

We have considered what the allegedly distinguishing language requires, *supra*. We are not persuaded that the language requires anything different from the “downloadable” applications described by Devarakonda (FF 1-4). The downloaded browser application (Devarakonda Fig. 1) and mail application (Fig. 6), for example, have not been demonstrated as incapable of interworking with the other application programs (e.g., the browser and mail applications) on another terminal in the network for realizing user services (e.g., WWW and electronic mail services). We note,

further, that in Appellant's system the downloaded application programs that implement a particular user service are, preferably, JAVA applets, as in Devarakonda (col. 4, ll. 43-47). (*See Spec.* Feb. 9, 2005, ¶ [0059].)

We have *not* considered the expanded arguments by the new attorney in the Reply Brief, as the arguments could have been presented in the Appeal Brief such that we might have had benefit of the Examiner's views in the Answer. We decline to address the untimely arguments in the first instance and we decline to remand the proceeding to the Examiner for answer to those arguments. We note, however, that the new arguments appear to quote claim language at length and make general allegations that the language is "not the same" or "very different" in comparison to the Devarakonda disclosure, in addition to picking the wrong server in the reference (Reply Br. 8) to allege error in the Examiner's rejection.

We are thus not persuaded of error in the rejection of claim 16. Claims 17-20 and 24-26 fall with claim 16. We therefore sustain the rejection of claims 16-20 and 24-26 under 35 U.S.C. § 102(e) as being anticipated by Devarakonda.

#### *Obviousness*

The Examiner rejects claims 30 and 31 under § 103(a) over the combined teachings of Devarakonda and Bocker. Appellant submits that "substituting" the "virtual environmental manager" of Devarakonda with the "task control module" of Bocker would, for some unexpressed reason, "create a redundancy in application execution." (App. Br. 12.)

Instant claim 30 recites that the system of claim 16 further comprises an application execution component for executing “the [unidentified] application program, said application execution component being ported to the terminal only once.”

According to the Specification filed February 9, 2005, the “application execution environment” may be implemented as a JAVA virtual machine, such that the virtual machine has to be ported to each supported terminal “only once.” (Spec. Feb. 9, 2005, ¶¶ [0056] - [0059].)

Devarakonda teaches that the VEM may be downloaded from a service provider (col. 2, ll. 41-61), which is “only once” as far as claim 30 requires. The VEM is present on the terminal, and does not need to be reloaded unless and until the terminal is rebooted (col. 2, l. 62 - col. 3, l. 23). Devarakonda also teaches, however, both JAVA virtual machines and software that may be resident as an integral part of the terminal (col. 3, ll. 3-10).

Thus, even assuming that the “only once” recitation requires a component that remains resident on a terminal (e.g., in persistent memory) after initial “porting,” we need not go beyond Devarakonda to demonstrate prima facie obviousness of the claimed subject matter. We find no indication of anything in the record that would suggest anything unpredictable to one of ordinary skill in the art for the VEM described by Devarakonda to permanently reside on a terminal. *See KSR*, 550 U.S. at 416.

We thus do not consider claim 30 to be rejected in error. We sustain the rejection of claims 30 and 31 under § 103(a) over Devarakonda and Brocker.

#### DECISION

The rejection of claims 16-20, 24-26, 30, and 31 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 16-20 and 24-26 under 35 U.S.C. § 102(e) as being anticipated by Devarakonda is affirmed.

The rejection of claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Devarakonda and Brocker is affirmed.

The Examiner's decision to reject claims 16-20, 24-26, 30, and 31 is thus affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

#### AFFIRMED

msc

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